

## REMARKS

Claim 1 is amended. Claims 1-51 remain in the application.

The amendment to claim 1 is supported in the specification at page 68, lines 25-29. Accordingly, the amendment does not introduce new matter.

Claims 1-51 are provisionally rejected for obviousness-type double patenting over claims of the applicants' co-pending application Serial No. 09/728,693. In view of the fact that prosecution is still ongoing in that application, the applicants reserve response to this provisional rejection until all other issues of patentability are settled in both applications.

Claims 1-51 are provisionally rejected for obviousness-type double patenting over claims of the applicants' co-pending application Serial No. 09/679,038. In view of the fact that prosecution is still ongoing in that application, the applicants reserve response to this provisional rejection until all other issues of patentability are settled in both applications.

Claims 1-51 are provisionally rejected for obviousness-type double patenting over claims of the applicants' co-pending application Serial No. 09/679,039. In view of the fact that prosecution is still ongoing in that application, the applicants reserve response to this provisional rejection until all other issues of patentability are settled in both applications.

Claims 1-4, 9, 10, 15-17, 23-25, 27-30, 33, 34, 41-48, and 50 are rejected for anticipation by US Patent No. 5,848,397 ("Marsh"). That rejection is respectfully traversed as follows.

Axiomatically, rejection of a claim for anticipation by a reference requires that the reference describe every element or step of the rejected claim, together with each limitation thereof, explicitly or inherently.

Taking claim 1 as representative, a client device configured for communications with a multiplicity of other client devices via a communications network is claimed. The client device includes:

"means for effecting an advertisement download communication link between the client device and an advertisement distribution server system, via the communications network, at selected advertisement download times;

means for effecting a data communication link with a data communications service provider, via the communications network, wherein the advertisement download communication link and the data communication link are separate communication links;

the data communications service provider being separate and independent from the advertisement distribution server system;

means for downloading advertisements from the advertisement distribution server system via the advertisement download communication link;

means for storing downloaded advertisements on a storage medium associated with the client device; and

means for displaying at least selected ones of the stored advertisements, in accordance with ad display parameters prescribed by the advertisement distribution server system.”

In claim 1, the data communications service provider is “separate and independent from the advertisement distribution server system” from which the client device downloads advertisements. That is to say, data communications are provided to the client device from a data communications service provider that is “separate and independent” from the advertisement distribution server system from which the client device obtains advertisements, on a data communications link that is separate from the advertisement download link on which the client device downloads the advertisements. For the client device of claim 1, data communications are entirely separate from advertisement traffic, from source to destination.

In Marsh, however, all information received by the client computer - e-mail messages, advertisement archives, software patches, configuration data, and pop data – comes from a single server system 104 comprised of commonly-controlled mail servers. The server system 104 obtains advertisements from an advertiser 108 and interleaves the advertisements with e-mail, delivering e-mail and advertisements together in batch mode. See FIG. 8 and column 16, lines 19-32 of Marsh in this regard. For the client device of Marsh, data communications and advertisement traffic are inextricably merged together in a single seamless channel. As pointed out in the specification of this patent application at page 68, line 25 through page 69, line 6:

“The present invention also encompasses an e-mail software product that incorporates a control function for automatically downloading advertisements from a remote server system which is separate and independent from the e-mail server system, as well as the system and method for automatically distributing

the advertisements to client devices which have this e-mail software product installed thereon. In particular, the system includes an ad server system that manages, administers, and controls the distribution of advertisements, and which is controlled by a control entity (e.g., one operated by the present assignee, QUALCOMM INCORPORATED) which is separate and independent from the control entity which controls the e-mail server system which provides e-mail services to any particular client device which has this e-mail software product installed thereon. Thus, in sharp contrast to the Juno Online Services system, in accordance with this aspect of the present invention, the ad server system and the e-mail server system are operated independently, i.e., under the control of separate and independent control entities.”

Marsh's system *is* the Juno Online Services System. In Marsh's e-mail system, advertisements are downloaded to subscribers when they connect to the proprietary mail server system to send and/or receive e-mail messages. According to Marsh's free e-mail system, both the advertisements and the e-mail messages are stored on a single e-mail system (e.g., Marsh stores both advertisements and e-mail on a single, unique server system which is assigned (bound) to the user when he/she first signs up for service), and are distributed to subscribers from the e-mail system under the direction of a single common control entity that controls all parts of the mail system. While this may be a desirable system architecture for providing free e-mail service, it is not a suitable system architecture for a system whose purpose is to distribute advertiser-supported e-mail software that is e-mail system-independent, i.e., which is not tied to a particular proprietary e-mail service provider but, rather, supports public standards, e.g., POP3, SMTP, IMAP4, etc. Nor is Marsh's system architecture appropriate for a user who maintains many different e-mail accounts with many different providers.

Marsh therefore omits “the data communications service provider being separate and independent from the advertisement distribution server system” and does not anticipate claims 1-4, 9, 10, 15-17, 23-25, 27-30, 33, 34, 41-48, and 50.

Claims 5-8, 11-14, 18-22, 26, 31, 32, 35-40, and 51 are rejected for obviousness over Marsh. That rejection is respectfully traversed for reasons already of record and further for the reason that there is no suggestion to modify Marsh to a system in which “the data communications service provider” is “separate and independent from the advertisement distribution server system”. Marsh, in fact teaches away from such a configuration. “In general, the advertisement display scheduler 700 of the present invention receives all of the advertisements it will show from the server system 104.”

Accordingly, in view of the amendments and remarks made in this paper, it is submitted that claims 1-51 define subject matter that is patentably distinct from Marsh and the other references of record, early notice of which is earnestly solicited.

Respectfully submitted,

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By: Robert J. O'Connell  
Robert J. O'Connell  
Attorney for Applicants  
Registration No. 44,265

QUALCOMM Incorporated  
5775 Morehouse Drive  
San Diego, California 92121

Telephone: (858) 651-4361  
Facsimile: (858) 658-2502